

Appl. No. : 09/808,421  
Filed : March 13, 2001

### REMARKS

In the Office Action, the Examiner rejected the pending claims under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,470,338 ("Rizzo"), in view of U.S. 2002/0038233 A1 ("Shubov") and U.S. Patent No. 5,964,839 ("Johnson").

Applicant has amended pending Claims 1-4, 6 and 74 and 75 to claim specific embodiments of Applicant's invention wherein the claimed agreements include data that represent a promise. Applicant respectfully requests that the rejections be withdrawn and that the application be passed to issuance.

**A. Applicant's Claims Are Directed To Systems And Methods For Facilitating Services**

The Examiner repeatedly characterizes Applicant's claims as directed to systems for matching potential clients with service providers that meet certain criteria. *E.g.* Office Action at 2, 6, 7, 11. Applicant's claims, however, are expressly directed to systems and methods for facilitating services; and Applicant's claims should be characterized by the words specifically used in the claims.

**B. Claims 1, 2 And 74 Are Allowable**

**1. Neither The Rizzo Reference Nor Any Other Reference Discloses Anything Used For Providing Services, Any Agreement To Use Anything To Provide Services, Or Any Data Representing A Promise To Use Anything To Provide Services**

As indicated in the Office Action, the Examiner considers that Rizzo discloses "receiving an agreement from said service provider to user [sic] a computer-based communication-enhancing system to provide services to the client." Office Action at 3-4. The "agreement" that the Examiner finds disclosed in Rizzo is nothing more than the act of an attorney submitting a user ID and password to send e-mail to a potential client. The Examiner has taken the position that the sending of a password-based e-mail is the same thing as receiving an agreement to use a communication-enhancing system to provide services. The Examiner explained that this position has been taken "under a broad, yet reasonable interpretation." Office Action at 15.

Applicant has amended independent Claims 1 and 74 to specifically clarify that the claimed "agreement" includes data representing a promise by the service provider to use the computer-based communication-enhancing system to provide services to the client. The

Appl. No. : 09/808,421  
Filed : March 13, 2001

disclosure in Rizzo of the act of an attorney using an ID and password to send an e-mail to a potential client does not teach or suggest any promise by a service provider to use a communication-enhancing system to provide services. Rather, at most, it reflects a single instance of a purposeful decision to send an e-mail to a potential client. Moreover, nothing in Rizzo even suggests that e-mail might be used when services are being provided, and certainly there is no hint of any agreement or any promise by anybody to do so. Neither Rizzo nor any other cited art teaches receiving an agreement that includes data representing a promise to use any system to provide services. Applicant submits that neither Rizzo nor any other cited art teaches or suggests Claim 1 or Claim 74 as amended. Applicant respectfully requests that the rejections to Claims 1 and 74 be withdrawn.

Applicant also maintains that the "agreement" limitations in Claims 1 and 74 are not taught or suggested by any of the art of record even without the amendments to include "data representing a promise." Applicant maintains that there is not a single word of disclosure in Rizzo that relates to any system or method used in the performance of services, let alone any agreement to use any type of system or method to provide services. Rizzo discloses nothing about facilitating the actual providing of services. Applicant disagrees with the findings of unpatentability and presently intends to submit a continuation application to pursue broad claims to which Applicant is entitled.

**2. Neither The Rizzo Reference Nor Any Other Reference Discloses Monitoring The Frequency Of Service-Related Communications Between A Client And A Human Service Provider**

Claims 1 and 74 both recite "monitoring . . . a frequency of service-related communications between said service provider and said at least one client . . ." The Examiner argues that the Johnson reference discloses "monitoring the frequency of service-related communications between the provider and the client." Office Action at 5. But Johnson discloses only a data monitor system for monitoring real-time data packets transmitted between a computer and an on-line information service (e.g., CompuServe or Prodigy). Applicant amended Claims 1 and 74 to make clear that the service provider is a human. Johnson says nothing about monitoring the frequency of communications between a client and a human service provider. Thus, for this additional reason, the rejections of Claims 1 and 74 should be withdrawn.

Appl. No. : 09/808,421  
Filed : March 13, 2001

The Examiner argues, based on taking Official Notice, that it is well known that services are performed by humans, and that the limitation "wherein the service provider is human" does not distinguish the claimed invention over the prior art. Office Action at 5. To the contrary, there is no disclosure in Johnson or any other art of record of any monitoring of any frequency of communications between a human service provider and a client. Johnson's disclosure of monitoring real-time packets between a computer and an on-line service does not even come close. Nor does the fact (even if supported) that services are provided by humans make it obvious to monitor the frequency of communications involved in the rendering of the services. Nothing of record supports such a finding.

**3. The Rejections Of Claims 1, 2 And 74 Should Be Withdrawn**

For at least the reasons provided above, Applicant respectfully requests that the rejections of Claims 1 and 74 be withdrawn. Moreover, because Claim 1 is allowable and because Claim 2 depends from Claim 1, Claim 2 is also allowable. In addition, Claim 2, as amended, is also allowable because none of the art of record discloses, teaches or suggests the recited agreement from the second service provider that includes "data representing a promise" by the second service provider to use the second computer-based service-enhancing system.

Applicant respectfully requests that the rejections of Claims 1, 2 and 74 be withdrawn.

**C. Claims 3, 4, 5 And 6 Are Allowable**

**1. The Art Of Record Fails To Disclose Receiving An Agreement That Includes Data Representing A Promise By A Service Provider To Communicate With Clients In Accordance With A Predetermined Frequency**

Applicant amended Claim 3 to further clarify the "agreement" recited in the following limitation:

receiving an agreement from said service provider to communicate with clients in accordance with a predetermined communication frequency while providing services, said agreement from said service provider including data representing a promise by said service provider to communicate with said clients in accordance with said predetermined communication frequency;

Nothing in any of the art of record discloses, teaches or suggests this limitation.

Appl. No. : 09/808,421  
Filed : March 13, 2001

The Examiner acknowledges that Rizzo, Shubov and Johnson fail to disclose the claimed limitation of "receiving an agreement from said service provider to communicate with clients in accordance with a predetermined communication frequency." Office Action at 9. The Examiner argues that it is well known that a lawyer must communicate with a client, and further argues that it is well known that lawyers and clients agree to a "predetermined communication frequency." But the Examiner has provided no evidence of such an agreement. Applicant submits that the fact that lawyers communicate with clients cannot be bootstrapped into any notice of or any teaching or suggestion of any agreement to communicate with a predetermined communication frequency. In addition, Claim 3 as amended requires that the recited agreement includes "data representing a promise." Nothing in any of the art of record teaches, discloses or suggests receiving an agreement that includes such data.

**2. Nothing Discloses Monitoring The Frequency Of Service-Related Communications Between A Client And A Human Service Provider**

In addition, as explained above in connection with Claims 1 and 74, there is no disclosure in Johnson or any other art of record of any monitoring of any frequency of communications between a human service provider and a client. Monitoring data packets sent between a computer and an on-line service like Prodigy does not even come close.

For at least these reasons, Claim 3 is not taught, disclosed or suggested by any of the art of record, alone or in combination. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 3.

**3. Claims 4, 5 and 6 Are Allowable**

Claims 4 and 5 depend from Claim 3 and thus they are allowable for all of the reasons that Claim 3 is allowable.

In addition, Applicant has amended Claim 4 to further clarify the recited "agreement" as follows:

The method of claim 3, wherein said receiving an agreement from said service provider includes receiving data representing a promise by said service provider ~~an agreement~~ to use a computer-based system to communicate with clients.

Appl. No. : 09/808,421  
Filed : March 13, 2001

As explained above, Rizzo does not teach any such agreement, much less an agreement being received that includes data representing a promise to use a computer-based system to communicate with clients.

Applicant also amended Claim 6 to further clarify the recited "agreement" as follows:

Receiving a second ~~an~~ agreement from said service provider not to pass on to any client any cost of using said computer software-based process, said second agreement including data representing a promise by said service provider not to pass on to any client any of said cost

The Examiner argues that the terms of the "agreements" recited in Claims 4 and 6 are "nonfunctional descriptive material" that is not functionally involved in the recited claim. Office Action at 10. The Examiner makes this argument relying upon the decisions reported in *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994). But neither of those cases supports the "descriptive material" argument, and in fact both cases support the patentability of Applicant's claims.

First, as reported in *In re Gulack*, the Federal Circuit noted that a descriptive material rejection under Section 103 "stands on questionable legal and logical footing." *Id.* at 1385 n.8. The Federal Circuit noted that its predecessor court, the CCPA, whose decisions are binding, "clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated." *Id.*

Second, the Federal Circuit stated that what is required is "the existence of differences" between the claims and the prior art sufficient to establish patentability. *Id.* at 1386. "The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive." *Id.* The critical question is whether there is any new and unobvious functional relationship between the printed matter and the rest of the claim. *Id.* In this case, with respect to both Claims 4 and 6, there is plainly an undeniable relationship between the service provider's agreement and promise and the use of the computer-based system to communicate. The agreement and promise have significant meaning pertaining to the use of claimed items in the claimed methods. Indeed, the functional relationship in this case between the terms of the agreement and the steps in the claimed methods is not taught or suggested in the art of record and

Appl. No. : 09/808,421  
Filed : March 13, 2001

is far stronger and much more tangible than the functional relationship that was found to exist in the *Gulack* case between a series of numbers and the band around which they were printed.

Third, in the *Lowry* case, the Federal Circuit found that claimed “data” constituted structure. *Lowry*, 32 F.3d at 1583. The Court concluded that data were not subject to a printed matter rejection, and the Court rejected the Board of Patent Appeals’ conclusion that the data were printed matter and had no functional relationship to the rest of the claim. The Federal Circuit stated that the Board was not at liberty to ignore limitations that recited the data. *Id.* at 1584. As in the *Lowry* case, amended Claims 4 and 6 recite “data,” and the limitations reciting the “data” cannot simply be ignored.

In sum, Claims 4 and 6 are allowable for the above reasons, independent of the fact that they are allowable because Claim 3 is allowable.

**D. Claim 75 Is Allowable**

Applicant amended Claim 75 to further clarify the “agreement” recited in the following limitation:

means for receiving an agreement from said service provider to communicate with said at least one of said potential clients in accordance with a predetermined communication frequency while providing services, said agreement from said service provider including data representing a promise by said service provider to communicate with said at least one of said potential clients in accordance with said predetermined communication frequency; and

Nothing in any of the art of record discloses, teaches or suggests this limitation.

The Examiner acknowledges that Rizzo, Shubov and Johnson fail to disclose the claimed limitation of “means for receiving an agreement from said service provider to communicate with said at least one of said potential clients in accordance with a predetermined communication frequency while providing services.” Office Action at 13. The Examiner argues that it is well known that a lawyer must communicate with a client, and further argues that it is well known that lawyers and clients agree to a “predetermined communication frequency.” But the Examiner has provided no evidence of such an agreement. Applicant submits that the fact that lawyers communicate with clients cannot properly be treated as any teaching or suggestion of an

Appl. No. : 09/808,421  
Filed : March 13, 2001

agreement to communicate according to a predetermined communication frequency. In addition, Claim 75 as amended requires that the recited agreement includes "data representing a promise." Nothing in any of the art of record teaches, discloses or suggests receiving an agreement that includes such data.

### CONCLUSION

Applicant's claims are expressly directed to systems and methods for facilitating services. The present rejections are based on art relating to "matching systems" – neither of which discloses anything for facilitating services – and one technique for real-time data monitoring of data packets. Even assuming a motivation to combine these references, which Applicant contests, the three references taken together (1) fail to disclose any agreement to use a service-enhancing or communication-enhancing system to provide services, (2) fail to disclose any agreement that includes data representing a promise, (3) fail to disclose monitoring service-related communications between a human service provider and a client, and (4) fail to disclose monitoring a frequency of communications between a human service provider and a client.

In addition, the terms of the agreements recited in Claims 4 and 6 plainly bear a functional relationship between the service provider's agreement and promise, on the one hand, and the use of the computer-based system to communicate on the other. The agreement and promise have significant and unobvious meaning pertaining to the use of claimed items in the claimed methods, and may not be regarded as nonfunctional descriptive material.

Applicant respectfully requests that the present application be passed to issuance. If there are any remaining impediments, the Examiner is invited to call the undersigned. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,  
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10/1/07

By: 

Douglas G. Muehlhauser  
Registration No. 42,018  
Attorney of Record  
Customer No. 20,995  
(949) 760-0404